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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/639,928 | 08/12/2003 | Ralph M. Terrazas | 59952-010400 | 7311 |
| 33717 | 7590 | 02/07/2005 | EXAMINER | |
| GREENBERG TRAURIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404 | | | GONZALEZ, MADELINE | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2859 | |

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/639,928

Applicant(s)

TERRAZAS, RALPH M.

Examiner

Madeline Gonzalez

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

In response to applicant's amendment dated November 8, 2004

Claim Objections

1. Claim 1 is objected to because of the following informalities:
 - a) Claim 1: "an" in line 3 should be replaced with --a--.
 - b) Claim 1: The claim recites the limitation "the text" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Appropriate correction is required.

2. Claims 4-6 and 16 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 includes the limitation "at least one type of rate of spread scale, selectively being at least one of a historical time and real time". This limitation implies that only one scale is needed in order to meet the limitation. The Examiner has selected the real time scale.

Claim 4 depends on claim 3, and claim 3 depends on claim 1. Claim 4 includes the limitation "wherein the historical rate of spread scale is designed to address two brush fire

Art Unit: 2859

environments". Claim 4 is not further limiting claim 1 since it does not include limitations regarding the real time scale.

Claims 5, 6 and 16 are objected due to their dependency on claim 4.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

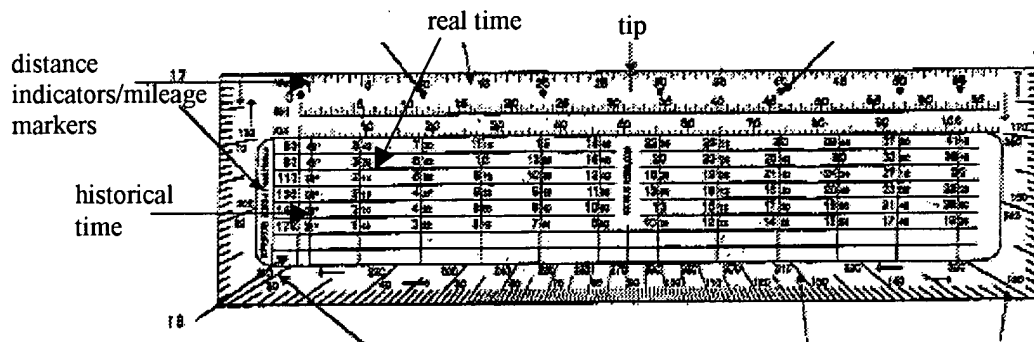
4. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganivet (U.S. 6,658,746).

Ganivet discloses a tool, as shown in Fig. 1, having:

- a geometric plotting element 10;
- at least one type of rate of spread scale (the rate of spread is the time for a segment of a route), selectively being a real time, related on the surface of the element 10;
- wherein, in use, the tool is oriented so that text on the tool is readable on a map;
- wherein the base of the tool contains the real time rate of spread scale that is calibrated into a 30-minute time projection;

Art Unit: 2859

- wherein, in use, upon receipt of the real time rate of spread from an observation source, the real time projection is plotted;
- wherein, in use, the tool is used for multiple projections upon the same map, and selectively different colors can be used for different projections;



- wherein the tool includes historical and real time rate of spread scales, and distance indicators to identify mileage;
- wherein on a long axis of the tool there are mileage markers;
- wherein there is a marker to gauge width, including at its center, a mileage marker indicating a predetermined distance in each direction from the centerline, and wherein in use the long axis is perpendicular to a width;
- wherein the tool contains at least one tip about which the tool is pivotable, the tip of the tool being blunted in shape, the shape being selected to reduce the tendency of breakage of the tip when the tool is used in a pivoting motion while identifying lateral spread upon a map;

Art Unit: 2859

- at least one hole 16 in the face of the tool, the holes being sized to accommodate a marker instrument;
- wherein, in use, when at least one, and preferably three, time zones are marked, the tool is removed, and a straight edge of the tool is used to create a straight line by aligning the edge over the dots to permit the drawing of a straight line;
- holes 16, spaced along mileage markers on the tool at predetermined distance intervals for use when using multi-page maps; and
- wherein a tool scale is employed to ensure a correlating map is used in conjunction with the tool.

Ganivet lacks the specific use of the tool stated on claims 1, 3, 7, 9, 10, 13, 20 and 22, the limitations of claims 4-6, 16 and 21, the specific shape of the tool and the specific dimensions of the tool.

With respect to the specific use of the tool stated on claims 1, 3, 7, 9, 10, 13, 20 and 22: The claims recite the limitations: “wherein, in use, the tool is oriented so that the text on the tool is readable for a moving fire depicted on a map”; “the real time scale utilizes GPS technology”; “wherein, in use, the tool is oriented so that the text on the tool is readable for a fire moving transversely on a north oriented map”; wherein, in use, upon receipt of the real time rate of spread from an observation source, the real time projection from the current head of the fire is plotted”; “wherein, in use, the tool is used for multiple projections upon the same map, and selectively different colors are used for different projections”; and “wherein in use the long axis

Art Unit: 2859

is perpendicular to a fire's width". These limitations have not been given patentable weight because a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the tool disclosed by Ganivet is capable of performing the intended use limitations.

With respect to limitations of claims 4-6, 16 and 21: These claims are considered "product by process" claims since they are directed to a product, i.e., historical rate of spread scale and delineation of projections, etc., but contain process steps for making the historical rate of spread scale and delineation of projections. Accordingly, the process steps have been given no patentable weight since it has been held that 1) the determination of patentability in "product by process" claims is based on the product itself, even though such claims are limited and defined by the process, and 2) the product in a "product by process" claim is unpatentable if it is the same as, or obvious from a product of the prior art, even if the prior art product was made by a different process. In re Thorpe et al., 227 USPQ 964 (Fed. Cir. 1985).

With respect to the specific shape of the tool: Ganivet discloses a tool having a rectangular shape. The specific shape claimed by applicant, i.e., a triangular shape, is only considered to be an obvious modification of the shape of tool disclosed by Ganivet as the courts have held that a change in shape or configuration, without any criticality, is within the level of skill in the art as the particular shape claimed by Applicant is nothing more than one of

Art Unit: 2859

numerous shapes that a person having ordinary skill in the art will find obvious to provide using routine experimentation based on its suitability for the intended use of the invention. See *In re Dailey*, 149 USPQ 47 (CCPA 1976). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the shape of the tool disclosed by Ganivet with a triangular shape in order to provide a triangular tip to easily grasp the tool.

With respect to the specific dimensions of the tool: Ganivet discloses a tool being of a predetermined length and width. To choose dimensions of about 21" long and about 10 ¼" wide, is only considered to be the " optimum " value of the length and width of the tool disclosed by Ganivet, as stated above, that a person having ordinary skill in the art would have been able to determine using routine experimentation based, among other things, on the desired accuracy and since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. See *In re Boesch*, 205 USPQ 215 (CCPA 1980). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the tool disclosed by Ganivet of about 21" long and about 10 ¼" wide in order to easily see the scales.

Response to Arguments

5. Applicant's arguments with respect to claims 1-28 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2859

Conclusion

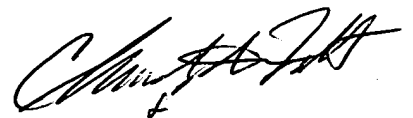
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. LiCalsi discloses a fire protection calculator.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeline Gonzalez whose telephone number is (571) 272-2243. The examiner can normally be reached on Monday-Friday (8:00-5:30), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (571) 272-2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MG



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